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10/022,649	12/17/2001	Francis D. Palazzo	4665/5	1815

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EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
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2611

14

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/022,649

Applicant(s)

PALAZZO ET AL.

Examiner

Jason P Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/10/04 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 5/24/04 have been fully considered but they are not persuasive.

The amended claims still read on the Fries patent of record.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 5, 7-9, 11-12 and 14-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Fries (U.S. Patent No. 6,317,885).

Referring to claim 1, Fries discloses storing presentation guide software for presenting an electronic program guide at a user location (see Column 6, Lines 37-40).

Fries also discloses receiving the broadcast advertisement comprising audio, video and promotional metadata over a broadcast distribution network (see Column 3, Lines 24-28 for receiving audio and video over a broadcast distribution network, Column 3, Lines 66-67 and Column 4, Lines 1-3 for providing information pages (metadata), and Column 6, Lines 52-55 to teach that the information pages can be sent from advertisers, therefore teaching that the metadata is promotional metadata).

Fries also discloses analyzing the promotional metadata to determine one or more valid electronic program guide features (see Column 7, Lines 12-21 for reading metadata associated with a displayed page to determine how to adjust focus, and then draws the focus at the next location at step 510 in Figure 5, then a user can invoke a SELECT command in the program guide). The examiner notes other commands can be invoked, such as a PLAY command for a video recorder disclosed at Column 8, Lines 7-12.

Fries also discloses presenting options on a display device corresponding to the one or more valid electronic program guide features within the electronic program guide (see displaying a default page at Column 6, Lines 66-67 and Column 7, Line 1 and Figure 6 and also note Column 8, Lines 26-34 for displaying a list of options presented in the metadata (FocusDescriptor list)).

Fries also discloses displaying an electronic program guide (see Column 6, Lines 43-48).

Fries also disclose executing a valid electronic program guide feature selected by the user (Column 8, Lines 7-12 for executing a PLAY command).

Referring to claim 3, Fries discloses receiving the promotional metadata as data encoded into a private data packet transmitted over the broadcast distribution network (Column 5, Lines 37-50 and Lines 59-67 for decoding packets according to there PID). Also note Column 22, Lines 61-67 and Column 23, Lines 1-15 for a description of the private message data contained within the metadata transmitted to a user. Since the metadata contained in a packet has it's own PID for identification at the receiver end, it is inherent that this packet be a private data packet, since it is separate from the audio and video packets.

Referring to claim 5, Fries inherently discloses traversing (moving something from once place to another) the promotional metadata one data element at a time. Since the data is transmitted in an MPEG2 stream using packets, a packet can be considered one data element, therefore the data is traversed from the head-end to the receiver one packet at a time.

Referring to claim 7, Fries discloses that the promotional metadata comprises one or more valid electronic program guide features consisting of purchasing a pay-per-view event (see Column 13, Lines 53-64).

Referring to claim 8, Fries discloses recording a promotional advertisement (see the Table at Column 18 for a discloser of a RECORD command). The examiner notes that a time can be set for the record command, therefore it is inherent that a commercial or an infomercial can be set for recording, which are both promotional advertisements.

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Referring to claim 9, Fries discloses a local recording device (see VCR at Column 6, Lines 27-28).

Referring to claim 11, Fries discloses a full-screen advertisement (see Figure 8).

Referring to claim 12, Fries discloses presenting the advertisement within an electronic program guide (see Figure 6).

Referring to claims 14-15, see rejection of claim 1. Note that the electronic program guide in Figure 8 displays an advertisement for ordering merchandise.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fries (U.S. Patent No. 6,317,885).

Referring to claim 2, Fries teaches all of the limitations in claim 1, but fails to teach transmitting the promotional metadata in the VBI of the video signal. The examiner takes Official Notice that it would have been obvious to include the promotional metadata in the VBI for the purpose of simultaneously transmitting promotional data at the same time audio and video data relating to the promotional metadata are transmitted to a user.

Referring to claim 10, Fries teaches all of the limitations in claim 8, but fails to teach that the promotional advertisement is recorded to a local recording device. The

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examiner takes Official Notice that it would have been obvious to use a VCR or TIVO to record the promotional advertisement for the purpose of allowing a user to watch a promotional advertisement (or other video program) at a more convenient time for the user.

5. Claims 4, 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fries (U.S. Patent No. 6,317,885) in view of the TV Anytime as an application scenario for MPEG-7 article by Pfeiffer and Srinivasan.

Referring to claim 4, Fries discloses all of the limitations in claims 1, but fails to teach parsing the metadata into a set of individual data elements. The article entitled "TV Anytime as an application scenario for MPEG-7" by Pfeiffer and Srinivasan teaches an XML schema processor for parsing metadata for presentation of this data on an EPG (see Page 90, first column, last paragraph and Page 90, second column second paragraph). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the set-top box in Figure 3, as taught by Fries, by including the XML schema processor, as taught by Pfeiffer and Srinivasan, for the purpose of adding value-added interactive services, that allows end users to personalize and control the material of interest (see Page 89, column 1, second paragraph of Pfeiffer and Srinivasan).

Claim 6 directly relates to claim 4 by including the XML schema processor of Pfeiffer and Srinivasan in the set-top box of Fries. The examiner notes that this processor will provide the set-top box of Fries with the ability to process metadata in the form of XML for the same purpose and motivation as shown in the rejection of claim 4.

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Referring to claim 13, Fries teaches all of the limitations of claim 13 in the rejection of claim 1, with the exception of parsing the promotional metadata to determine the one or more valid electronic program guide features that are available. The examiner notes that Pfeiffer and Srinivasan teach this limitation and motivation for combining in the rejection of claim 4.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 28, 2004

  
**VIVEK SRIVASTAVA**  
**PRIMARY EXAMINER**